

Appln. No. 10/016,990
Amendment dated July 22, 2003
Reply to Office Action mailed 4/23/03

REMARKS

Reconsideration is respectfully requested.

Entry of the above amendments is courteously requested in order to place all claims in this application in allowable condition and/or to place the non-allowed claims in better condition for consideration on appeal.

Claims 1, 2, 6 through 8, 10, 17, 18, and 20 through 22 remain in this application. Claims 3 through 5, 9, 11 through 16, and 19 have been cancelled. No claims have been withdrawn. Claims 25 through 29 have been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Parts 1, 2 and 4 of the Office Action

Claims 1 through 4, 7, 10, 11, 17, 18 and 20 through 24 have been rejected under 35 U.S.C. §102(b) as being anticipated by Waddell (5,215,236).

Claim 5 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Waddell (5,215,236) in view of Walker et al. (4,928,864).

Claim 8 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Waddell (5,215,236).

Claims 2, 5, and 23 through 24 have been cancelled.

Claim 1 has been amended to include the requirements of claim 5, and now requires "wherein each of the transverse extents, the return extents, and the free end extents are arcuate such that a group of connected transverse, return and free end extents forms a portion of a circle"

In the rejection of claim 5, it is stated in the Office Action that "the

shape of the end extents is the applicant's design choice and does not change the utility of the invention". This allegation will be addressed first.

With regard to the matter of the relationships recited in claim 1 being merely a matter of design choice, it is noted that the Federal Circuit has spoken on the issue of when the allegation of "design choice" is not correct:

From the totality of the record, we hold that placement of the SCR catalyst within the bag retainer would not have been merely a matter of "design choice." First, there is no teaching or suggestion in the prior art that would lead one of ordinary skill in the art to modify the Szymanski structure to place the SCR catalyst within a bag retainer as opposed to between two filter bags as disclosed in Szymanski. Next, Chu's technical evidence relating to the frailty of fabric filters during pulse-jet cleaning clearly counters the assertion that placement of the catalyst in the baghouse is merely a "design choice." Specifically, Chu's evidence regarding the violent "snapping" action during pulse-jet cleaning, the difficulty in stitching compartments including the capacity to withstand high temperatures, and problems encountered from variable path lengths due to settling of the catalyst particles in each compartment militates against a conclusion that placement of the SCR catalyst is merely a "design choice." See *In re Gal*, 980 F.2d 717, 25 USPQ2d 1076 (Fed. Cir. 1992) (finding of "obvious design choice" precluded where the claimed structure and the function it performs are different from the prior art).

In re Chu, 36 USPQ 2d 1089, 1095 (Fed. Cir. 1995) (emphasis added)

Thus, if 1) the prior art does not motivate the modification of the prior art structure to achieve the claimed structure, and 2) there is a benefit that is associated with the claimed structure over the prior art structure, the claimed structure cannot be dismissed as "merely a design choice".

With respect to any motivation in the prior art to alter the Waddell structure to meet the claim 1 requirements, it is noted that the Waddell reference teaches a structure in which the end portions of the opposing sides 22 and 23 have a reverse or opposite curvature as compared to the curvature of the medial portions of the opposing sides 22 and 23. This is in direct contrast to the requirement of claim 1 in which "a group of connected

transverse, return and free end extents forms a portion of a circle". With respect to the structure of the Walker dispenser, it is difficult for one to discern from the drawings the exact shape of the end portions 13, as in Figures 1 and 2 of the Walker patent, one end portion 13 appears to be curved and the other opposing end portion appears straight. In any event, both the Waddell and Walker devices are designed to be worn on the hand, and more specifically the palm, of the user's hand so that the opposing sides 22 and 23 of Waddell and the end portions 13 of Walker extend across the palm of the user. It is submitted that one of ordinary skill in the art, considering the disclosures of Waddell and Walker, would not be lead to a portions that form a portion of a circle, as the ends of these structures would dig into the surface of the palm of the user, making the dispenser uncomfortable to wear as the inwardly curved ends dig into the palm of the user.

Further, the applicant has clearly stated in the specification of the application a benefit for a structure having this relationship at page 9 of the application. The ends of the mounting portion are more suitably positioned for exerting pinching pressure on the pew structure. Significantly, this pinching effect is exactly the opposite goal of one considering the Waddell and Walker references, in which pinching of the hand and the palm area of the user is not desirable as it produces discomfort. That is clearly why the end portions of Waddell and Walker are relatively short and straight, and longer, more curved end portions would dig into the skin of the user.

It is therefore submitted that the prior art, and especially the allegedly obvious combination of Waddell and Walker set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claim 1. Further, claims 2, 7, 10, 17, 18, and 20 through 22, which depend from claim 1, also include the requirements discussed above and therefore are also submitted to be in condition for

allowance.

Claim 17 requires, in part, "a securing portion for removably securing an ornamental item on the mounting portion, the securing portion having a first end being mounted on the mounting portion adjacent to a first one of the side edges of the mounting portion and a second end free of connection to the mounting portion and being biased against the outer face of the mounting portion, *the free second end of the securing portion extending past a second one of the side edges of the mounting edge*" (emphasis added). The benefits of this structure are set forth in applicant's specification at page 10, lines 29 through 24:

Further, the second end 39 of the securing arm 36 may extend beyond the side edge 18 of the mounting portion to thereby facilitate insertion of items between the securing arm and the mounting portion by permitting engagement of the second end by the user's finger or a portion of the item to be inserted to pull the second end away from the mounting portion.

Claim 17 is rejected based upon the disclosure of the Waddell patent. The Waddell structure includes a spring element 25 and 25' that that does not extend past the edge on which locking flange 28 is positioned. In fact, the end of the spring element is short of the locking flange (to permit space for accommodating the dispenser housing) and diverges away from the face of element 24 (see, e.g., Waddell at col. 5, lines 23 through 27).

It is clear that the Waddell reference would not lead one of ordinary skill in the art to these relationships between the free second end of the securing arm and the mounting portion, as this would interfere with the ability to mount a tape dispenser on the Waddell device and lock the dispenser in place on the Waddell device, thus destroying that functionality of the Waddell devices and making the dispenser vulnerable to slippage off of the Waddell clasp device.

The requirements of claim 21, 21, and added claim 25 through 29 all

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include requirements that are in conflict with this teaching of the Waddell reference.

Withdrawal of the §102(b) and §103(a) rejections of claims 1, 2, 7, 10, 17, 18, and 20 through 22 is therefore respectfully requested.

Part 3 of the Office Action

Claims 6 and 19 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Waddell (5,215,236) in view of DesSaulles (2,506,859).

Claim 19 has been cancelled.

Claim 6 requires “wherein each of the free end extents extends inwardly from one of the return extents, each of the free end extents being oriented generally perpendicular to the longitudinal extent”.

Again in the Office Action it is alleged that the relationship recited in claim 6 is merely a design choice. Addressing the Federal Circuit’s statements on “design choice” set forth above, it is noted that the claimed structural relationship of perpendicularity has a clear benefit set forth in applicant’s specification at page 9, lines 11 through 15:

The orientation of the free end extents at a substantially perpendicular orientation to the longitudinal extent concentrates the pinching pressure exerted by the mounting member on the paw support at the end edges, which have a relatively small area for increased holding capability.

Further, as noted in the earlier arguments, one of ordinary skill in the art, considering the Waddell teaching of a device for mounting on the palm of the user, would not be motivated to modify the Waddell clasp in a manner that would make the clasp less comfortable to wear as the end would dig into the palm of the user. Certainly the perpendicularity required by the language of claim 6 would cause that problem in the Waddell device.

Appln. No. 10/016,990
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Further, one of ordinary skill in the art would not consider the overlapping end portions of the Des Saulles reference as teaching "each of the free end extents being oriented generally perpendicular to the longitudinal extent". Significantly, the overlapping condition of the end portion of Des Saulles structure makes it difficult, if not virtually impossible, to orient the end portions in a perpendicular relationship to a longitudinal extent of a mounting portion.

Withdrawal of the §103(a) rejection of claim 6 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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